



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number
05725.1227-00000

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number
10/617,676Filed
July 14, 2003First Named Inventor
Frédéric LEGRANDArt Unit
1615Examiner
Hasan S. AHMED

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

Signature

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

Thalia V. Warnement

Typed or printed name

attorney or agent of record.

Registration number 39,064

(202) 408-4454

Telephone number

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

September 24, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief panel review of the rejections set forth in the final Office Action mailed April 23, 2007, and maintained in the Advisory Action mailed July 25, 2007. Applicant asserts that (1) the application has been at least twice rejected; (2) this request is being filed concurrently with a Notice of Appeal under 37 C.F.R. § 41.31; (3) this request is being filed prior to the filing of an Appeal Brief; and (4) this request is five or less pages in length, all in accordance with guidelines set forth in the O.G. Notice of July 12, 2005. No amendments are being filed herewith. The period for reply has been extended two months to September 23, 2007, by the petition for extension of time and fee payment filed herewith.

REMARKS

I. Status Of The Claims

Claims 1-32 are pending. Claims 1-22 remain rejected. Claims 23-32 have been withdrawn from consideration by the Examiner as being directed to non-elected subject matter. No amendments have been made in this response.

II. The rejection of claims 1-22 under 35 U.S.C. § 103(a) is improper.

The Examiner rejects claims 1-22 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,540,791 to Dias ("Dias"), in view of U.S. Patent No. 6,260,556 to Legrand et al. ("Legrand"), and further in view of U.S. Patent No. 6,423,306 to Caes et al. ("Caes") for reasons of record. Final Office Action, pages 2-5. The Examiner alleges that Dias teaches a hair bleaching composition comprising polydecene, nonionic amphiphilic polymers, peroxygenated salt, an alkaline agent, and surfactants as recited in the rejected claims. *Id.* at 2. The Examiner relies on Legrand and Caes for the disclosure of specific peroxygenated salts, hydrogen peroxide, and gelling agents not disclosed in Dias. See *id.* at 3-4. The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to make an anhydrous paste comprising a peroxygenated salt, an alkaline agent, a polydecene, and a gelling agent, as taught by Dias, in view of Legrand, and further in view of Caes. *Id.* at 5. Finally, in responding to Applicants' arguments of record, the Examiner alleges that "Dias shows that use of a polydecene compound having at least 30 carbon atoms in an anhydrous paste for bleaching human keratin fibers was within the level of ordinary skill at the time the claimed invention was made." *Id.* at 7; see also Advisory Action at 2. Applicants respectfully disagree and traverse this rejection.

Several basic factual inquiries must be made to determine whether the claims of a patent application are obvious under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 USPQ 467; see also *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1734 (2007). In order to satisfy the initial burden of establishing a *prima facie* case of obviousness, the Examiner must at least show that (1) the prior art references teach or suggest all the claim limitations and (2) there is some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references. See M.P.E.P. § 2143.

The Supreme Court, in its recent decision in the *KSR* case, recognized that a showing of "teaching, suggestion, or motivation" could provide helpful insight in determining whether the claimed subject matter is obvious under Section 103(a). *KSR*, 127 S. Ct. at 1741. In addition, the Supreme Court mandated that "[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit." *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

Following the *KSR* decision, the Office issued a memorandum to its technology center directors on May 3, 2007, indicating that "**in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.**" (Emphasis in original).

Applicants maintain that the Examiner has failed to satisfy the initial burden of establishing a *prima facie* case of obviousness. The Examiner provides mere conclusory statements and has failed to articulate reasoning with some rational underpinning for why one of

ordinary skill would choose to modify Dias, i.e., "combine the prior art elements," to arrive at the presently claimed composition.

A. There is nothing in Dias that would have put the presently claimed anhydrous paste "within the level of ordinary skill at the time the claimed invention was made."¹

In particular, the Examiner has failed to articulate a rationale for why one of ordinary skill would have chosen polydecene in general from the laundry list of organic conditioning oils disclosed in Dias in col. 22, l. 42 - col. 25, l. 15, let alone the specific polydecene as recited in, e.g., present claim 1, to formulate the anhydrous paste as presently claimed. Dias does mention pastes as one of many suitable forms for its composition. Col. 49, ll. 33-36. However, Dias does so without providing any detail whatsoever about whether such a paste is anhydrous.

Moreover, Dias does not even contemplate the problem addressed by the present invention: that certain bleaching pastes, e.g. those formulated with mineral oil, may cause hair to feel coarse or greasy. See Specification at p. 3, para. [010]. Therefore, in order to arrive at the presently claimed composition, a person of ordinary skill in the art would first have had to choose to configure the ingredients in Dias in the form of a paste, for which no direction is provided. Following that, he or she would have had to experiment with different compositions until arriving at the presently claimed composition: an anhydrous bleaching paste comprising certain claimed ingredients *and which*, when the claims are properly read in light of the specification, does not leave a greasy feel after bleaching. Dias provides no suggestion for going through this exercise and no suggestion of an anhydrous paste for bleaching human keratin fibers comprising a polydecene compound having at least 30 carbon atoms. Instead, as Applicants have argued in greater detail on the record and also below, Dias's composition is in the form of a *solution*, containing water-soluble components.

Therefore, contrary to the Examiner's allegations, one of ordinary skill in the art upon reading Dias, would not have been able to attain the composition of the instant claims.

B. Dias teaches away from an anhydrous paste.

The present application defines "anhydrous" paste as "a paste whose water content is less than 1%... relative to the total weight of the paste." Specification at p. 5, para. [020]. In contrast, Dias, taken as a whole, teaches away from an anhydrous product. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be

¹ Final Office Action at 7; see also Advisory Action at 2.

discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) (emphasis added). Dias' composition comprises, "as an essential feature," a buffering system comprising water soluble compounds. *Id.* at col. 7, ll. 2-10, 17-18, 60-61 (emphasis added). Dias discloses that its composition may comprise a diluent, which is preferably water. *Id.* at col. 44, ll. 65-67. Dias further discloses that the diluent be present at a level preferably between 5% and 99.98%. *Id.* at col. 45, ll. 15-16. All of the examples disclosed in Dias use water as a diluent. *Id.* at col. 50, l. 35. These disclosures, contained throughout Dias, all point away from an anhydrous product.

In response to Applicant's argument that, *inter alia*, Dias teaches water as a diluent and thus teaches away from an anhydrous product, the Examiner alleges that because Dias teaches "water as merely a *preferred* diluent" and mentions "alternatives to water," the "[d]isclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments." Final Office Action at 6 (citing *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971) and MPEP § 2123) (emphasis original).

The Examiner's reliance on *Susi* is improper. In *Susi*, the applicant argued that the subclass of a "more particularly preferred embodiment" taught away from the subclass of a "particularly preferred embodiment"; but the court determined that "one is not significantly 'taught away' from a 'particularly preferred embodiment' by the suggestion . . . that something else may be even better." *Susi*, 440 F.2d at 446, n. 3; 169 USPQ at 426, n. 3. Here, Dias discloses a single solution hair bleaching product, (col. 2, ll. 9-10 and 24-25) but does not differentiate between bleaching solutions and anhydrous pastes, nor prefer one over the other. The "alternatives to water," to which the Examiner refers to, are disclosed as "additional diluent materials," and are generally "selected to be miscible with water." *Id.* at col. 45, l. 1-4. In col. 50, ll. 36-44, Dias explains that, in the examples, alternative diluents such as lower alcohols can replace the water "in part." Dias does not suggest that the water can be replaced entirely.

Additionally, as the Examiner admits, "Dias. . . does not explicitly teach all the instant claimed percentage of agents." Final Office Action at 4. To address this deficiency, the Examiner alleges that it would have been "obvious to. . . determine suitable percentages through routine or manipulative experimentation." In response to Applicant's arguments of record that it would not have been obvious, the Examiner invokes *In re Woodruff*, alleging that "the applicant must show that the particular range is critical." *Id.* at 6. However, the Examiner's

reliance on the *Woodruff* case is improper. In *Woodruff*, the court determined that the claimed range overlaps the range disclosed in the prior art reference and held that the applicant must show that the particular range is critical. *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). Here, however, there is no need to make such a showing. Dias discloses that its composition may comprise, among a laundry list of organic conditioning oils, polydecene in an amount ranging from about 0.05% to about 3% by weight of the composition. Dias, col. 22, l. 42 - col. 25, l. 15. This range is indeed outside, and significantly lower than, the amount of the at least one polydecene ranging from 15% to 35% by weight of the total weight of the paste as recited in, for example, present claim 1. There is no overlap. This difference in concentration ranges of polydecene reflects the fundamental difference between the invention in Dias, which is directed to a bleaching solution, and the present invention, which is directed to an anhydrous paste. Therefore, one of ordinary skill in the art reading Dias, would not have been able to attain the parameters of the instant claims by routine experimentation, unless he or she had the benefit of improper hindsight.

As for the secondary references, the Examiner merely relies on Legrand and Caes for the disclosure of specific peroxygenated salts, hydrogen peroxide, and gelling agents. See Final Office Action at 3-4. Neither Legrand nor Caes remedies the deficiencies of Dias as set forth above.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicant respectfully request this rejection be withdrawn.

CONCLUSION

In view of the above arguments, Applicants submit that the present claims are in condition for allowance.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By:



Thalia V. Warnement
Reg. No. 39,064

Dated: September 24, 2007